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09/912,971	07/25/2001	Alexander Aschir	112740-263	6538
29177	7590	03/26/2004	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			ANWAH, OLISA	
			ART UNIT	PAPER NUMBER
			2645	10

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/912,971

Applicant(s)

ASCHIR, ALEXANDER

Examiner

Olisa Anwah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The term "outside the communication network" in claim 1 is a relative term which renders the claim indefinite. The term "outside the network" is not defined by the claim. How does one of ordinary skill in the art differentiate between "in a network" and "outside the network"? Figure 2 of Applicant's specification shows the schedule store (18) is coupled to network (4) via a gateway (7). Hence the combination of 9, 7 and 4 constitutes a telecommunications network and all the elements of Figure 2 are within the telecommunications network. Applicant broadly claims, "the schedule store being...outside the communication network". This claim language poses the question: **At what point is a network-coupled-element outside of the network?** While applicant may be his or her own lexicographer, Examiner advises the applicant to use terms such as **gateway, different service provider, different operators or different protocol.**

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Rogers et al, U.S. Patent No. 5,946,386 (hereinafter Rogers).

Regarding claim 1, Rogers discloses a method for establishing a communication connection in a communication network (see Figure 1) between a person seeking communication (118) and a communication partner (111) to whom a personal communication address is allocated, the method comprising:

addressing the personal communication address of the communication partner (col. 9, line 63);

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allocating an individual identification code of at least one communication terminal to the personal communication address depending upon time (columns 27 and 34);

reading out of a schedule store of the communication partner information about which individual identification code is allocated to the personal communication address of the communication partner at the time, the schedule store being administered by an appointments book program operated on a computer (101) that is arranged outside the communication network via which the person seeking communication (118) and the communication partner (111) can be connected (column 37); and

establishing the communication connection to the at least one communication terminal having the individual identification code (column 38).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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6. Claims 1-4 and 9 are rejected under 35 U.S.C § 103(a) as being unpatentable over Lautenschlager, U.S. Patent No. 6,571,100 (hereinafter Lautenschlager) in view of Cloutier, U.S. Patent Application Publication No. 2001/0055963 (hereinafter Cloutier).

Regarding claim 1, Lautenschlager discloses a method (see Figure 1) for establishing a communication connection in a communication network (KOM) between a person seeking communication (subscriber B) and a communication partner (subscriber A) to whom a personal communication address is allocated, the method comprising:

addressing the personal communication address of the communication partner (C1, Figure 3);

allocating an individual identification code of at least one communication terminal to the personal communication address (see abstract);

reading out of a store of the communication partner information about which individual identification code is allocated to the personal communication address of the communication partner, the store being administered by a program operated on a computer that is arranged outside the communication network via which the person seeking communication and the communication can be connected (columns 6 and 2);

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establishing the communication connection to the at least one communication terminal having the individual identification code (see abstract and M9 from Figure 3).

Lautenschlager does not disclose the allocating step depends upon time. Lautenschlager also fails to teach the store is a schedule store being administered by an appointments book program. However Cloutier discloses these limitations (see Figure 6). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lautenschlager with the schedule taught by Cloutier. This modification allows terminals to be prioritized as suggested by Cloutier and Lautenschlager.

Regarding claim 2, see Figure 5 of Cloutier.

Regarding claim 3, see paragraphs 0038 and 0040 of Cloutier.

Regarding claim 4, see Figure 6 of Cloutier and the abstracts of Lautenschlager and Cloutier. Also see column 5 of Lautenschlager.

Regarding claim 9, see Figure 1 of Lautenschlager.

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7. Claim 8 is rejected under 35 U.S.C § 103(a) as being unpatentable over Lautenschlager combined with Cloutier in further view of the Publication "Parlay APIs 2.1 Connectivity Manager Class Diagrams" of June 26, 2000 (hereinafter Parlay).

Regarding claim 8, the combination of Lautenschlager and Cloutier does not disclose a method wherein the computer and the communications network are connected via an interface operated in accordance with specifications of a Parlay Group. However Parlay discloses this method (see pages 4-15). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Lautenschlager and Cloutier with the method taught by Parlay. This modification allows for interfaces that are network independent as suggested by Lautenschlager and Parlay.

#### ***Response to Arguments***

8. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

#### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS**



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**ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 703-305-4814. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned

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are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

O.A.

Olisa Anwah  
Patent Examiner  
March 16, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

